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the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mark Twain Casino, LLC

Serial No. 76/309,178

Kristin J. Achterhof and Becky A. Williams of Katten Muchin
Zavis Rosenman for Mark Twain Casino, LLC.

Zachary R. Bello, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).¹

Before Simms, Seeherman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Mark Twain Casino, LLC [applicant] has applied to
register MARK TWAIN CASINO as a mark on the Principal
Register for "casino services" in International Class 41
and "restaurant and bar services" in International Class
42. The examining attorney has refused registration under
Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), basing

¹ Darshini Satchi issued the final refusal. Zachary Bello issued the initial refusal, summarily denied applicant's request for reconsideration and filed the appeal brief for the USPTO.

the refusal on the existence of registration no. 2,246,917, covering MARK TWAIN VACATIONS for "boat cruises" in International Class 39.

The cited registration issued May 25, 1999 and includes a disclaimer of exclusive rights to the term "vacations." The refused application includes a claim that applicant first used MARK TWAIN CASINO on February 16, 1995 for casino services, first used the mark on May 22, 2000 for restaurant and bar services, and first used the mark in commerce for all these services on July 25, 2001. The application includes a disclaimer of exclusive rights to the term "casino."

Applicant has appealed the refusal. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral argument on the appeal.

As a preliminary matter, the examining attorney has objected to the various items of evidence attached to applicant's appeal brief, asserting that "it is apparent applicant has attempted to submit additional evidence" with the brief, contrary to 37 C.F.R. §§ 2.142. In fact, it is apparent from our review of the file that the applicant has not attempted to submit additional evidence. Rather, the exhibits attached to the appeal brief are merely copies of exhibits previously, and properly, introduced. Brief

exhibits A, B and C were originally introduced in conjunction with applicant's request for reconsideration; exhibits D, E and F were originally introduced with applicant's response to the initial office action refusing registration. All of applicant's submissions have been considered.

Our determination under Section 2(d) of the question of likelihood of confusion is based on an analysis of all relevant analytical factors for which there is probative evidence of record. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the related nature of the services, see *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976), and the likely marketing of the services to the same class of prospective consumers.

We consider first the marks. Applicant argues that they are different because one includes the term VACATIONS and the other includes the term CASINO, thus resulting in composite marks that look and sound different and have different commercial impressions. We agree that the marks, considered in their entirety, are not identical in sight and sound, precisely because the respective third words are

different.² However, the terms VACATIONS and CASINO have been disclaimed because they are highly descriptive or generic and contribute little, if anything, to the source identifying capacity of the involved marks.³ Consumers will view the different end words in each mark as simply reflecting the different services with which each mark is used, rather than as significant elements of composite marks indicating separate sources.⁴

Because of the use of MARK TWAIN, each mark has a connotation of that author, his literary works and quotations. The overall commercial impressions of the marks differ slightly, because of the respective added terms, but the similar connotation of the author is present in each mark. MARK TWAIN CASINO has the overall impression

² Because applicant seeks to register its mark in typed form, we must consider the possibility that it could be displayed in the same style of lettering as registrant's mark, see *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971), which would yield some degree of visual similarity, notwithstanding the different third words in each mark.

³ While disclaimed terms are considered in the comparison of marks, and in an appropriate case may contribute to a finding of no likelihood of confusion, disclaimed matter is typically less significant or less dominant than other components of trademarks. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976).

⁴ We note that the specimens of use submitted by applicant as evidence of use of its mark show the name MARK TWAIN in larger letters of a different color than the word CASINO. The latter is smaller and set forth in the same color as the words "La Grange, Missouri." Such a display de-emphasizes the word CASINO and illustrates the dominant role of MARK TWAIN in applicant's mark.

of a casino named for a famous author from near the site of the casino. MARK TWAIN VACATIONS has the overall impression of vacations that will recall the lifestyle of the era in which the author lived and/or of the characters in the author's literary works.

Overall, we find the marks very similar for likelihood of confusion purposes. Applicant, however, argues that each mark should be accorded a limited scope of protection, because there are various other "Mark Twain" formative marks on the register. Specifically, applicant argues that when a search of the register reveals, as in this case, the registration of numerous marks "with... a common segment" it is the other portions of the marks that serve to distinguish one mark from another. This is an argument that may be raised with respect to marks that are in use; however, third-party registrations are not evidence that the marks depicted therein are in use, or are known by the public. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In any event, five of the seven third-party marks are for MARK TWAIN without any other term, so even if we were to accept that the public is familiar with them, it cannot be that these marks are distinguished based on the presence in each of an

additional, different term.⁵ Third-party registrations can, of course, be used to show that a term which has been commonly adopted has significance in a particular industry, such that the scope of protection of the cited mark does not extend to prevent the registration of another mark simply because it also includes that element. However, the goods and services in the third-party registrations submitted by applicant are so different from those at issue herein that we cannot say that MARK TWAIN has a particular significance in the vacation or entertainment industry.⁶ Accordingly, we do not find it appropriate to limit the scope of protection to be accorded the mark in the cited registration merely because of the other "Mark Twain" marks applicant has referenced.

We turn now to the services of applicant and registrant. The examining attorney has put in the record copies of information--retrieved from the USPTO's data base of registered marks--regarding approximately 65 third-party

⁵ Moreover, of the two registered marks that actually have another term one includes a disclaimer of "Mark Twain," so the registration for that mark does not support applicant's argument.

⁶ Discounting the registered mark that includes a disclaimer of "Mark Twain," the other six marks are registered for the following diverse goods and services: a train; various clothing items (two registrations, having the same owner); fresh citrus fruits; a series of musical sound recordings; and banking services.

registrations; and this information shows marks having been registered for cruise services on the one hand and casino services and/or bar and restaurant services on the other.⁷ This Board has often stated that third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The examining attorney has also put into the record reprints of some web pages downloaded from the World Wide Web and which show cruise ship lines featuring gaming and dining.

Applicant has attempted to differentiate the services by noting that its casino and bar/restaurant services are not offered on a ship. Applicant has also argued, relying on a reprint of a web page apparently posted on the World Wide Web by the owner of the cited registration, that registrant "is not a major cruise line offering casino services" and offers only vacation steamboat cruises. This web page includes a description of registrant's MARK TWAIN VACATIONS as a cruise that will take the passenger to

⁷ The terms used in the various identifications have some variation, but we see no appreciable difference between, for example, "food and beverage services" and "restaurant and bar services" when both are clearly services offered on cruise ships.

Hannibal, Missouri, to tour Mark Twain's boyhood home and participate in other "Tom Sawyer Days" events.

Notwithstanding that applicant does not offer its casino and bar/restaurant services on a cruise ship, there is no restriction in its identification of services to land-based services, and so we must consider applicant's identification to encompass services rendered both on land and on cruise ships. *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Indeed, the second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration"). Moreover, a news article entered into the record by applicant reveals that applicant's facility is a "riverboat-style casino" and "floats in an artificial basin of Mississippi River water." The same article also reveals that the casino is sited "about 35 miles north of Mark Twain's hometown of Hannibal," i.e., about 35 miles from where registrant's MARK TWAIN VACATIONS cruise passengers will disembark. It is reasonable to assume that applicant, in advertising its casino, would focus at least some of its efforts on a known tourist destination within a half-hour's drive, i.e., Hannibal. There is nothing in the record to suggest that applicant would eschew promoting its casino in Hannibal.

In fact, applicant has entered into the record a reprint of a web page posted July 26, 2001 by The Hannibal Courier Post (www.hannibal.net/stories/072601/com_0726010003.shtml) which reports on applicant's receipt of its license to operate a casino.

Even if we were to discount the possibility of applicant someday offering its casino and bar/restaurant services on an actual cruise ship rather than a ship-like facility in a basin of Mississippi River water, and even without considering whether operating a casino on one of its cruise ships would be within the natural zone of expansion for registrant, we find that confusion among prospective customers for applicant and registrant's services is likely. There are no restrictions in the identifications on classes of consumers and the involved services are all likely to be advertised generally to vacationers.

It is sufficient support for a finding of likelihood of confusion that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief

that they originate from the same source or sponsor. *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). That is, likelihood of confusion may exist even if the parties are not direct competitors, and the rights of the owner of a mark extend to any services that potential purchasers might think are related or emanate from the same source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Given that the marks each possess the connotation of the author Mark Twain, the related nature of the services, and the overlap between prospective patrons for the respective services, we find that there exists a likelihood of confusion, mistake or deception. Finally, if we had any doubt on the issue, we would have to resolve that doubt in favor of the registrant. *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal of registration under Section 2(d) of the Lanham Act is affirmed.